THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERVE HINNEKENS
and ANDRE DEMOULIN

Appeal No. 1997-0436
Application 08/277,692

ON BRIEF

Before DOWNEY, GARRIS and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 10, which are all of the claims in the application. Claims 1[1] and 6 are illustrative of the claims on appeal:

1. A compound suitable for use as a compressor lubricant, comprising an oil prepared by

[1] We have copied claim 1 as it stands of record with the chemical formula as amended in the amendment of August 22, 1995 (Paper No. 10; page 2), from which it is apparent that claim 1 as set forth in the appendix to appellants' brief is in error.

esterification of a polyoxyethylene represented by the following formula (I):

(I) CH_2-O-$(AO)_n$-H
?
CH-O-$(AO)_n$-H
?
CH_2-O-$(AO)_n$-H

wherein each n, which may be different from the others, represents an integer from 1 to 10, and AO is the oxyethylene group, with at least one polycarboxylic acid compound having from 2 to 20 carbon atoms, and at least one monocarboxylic acid compound having from 2 to 20 carbon atoms.

6. Use of the lubricant according to claim 5, in a closed refrigerator system which is of the compression type.

We select claims 1 and 6 for consideration of the respective issues in the two grounds of rejection advanced by the examiner on appeal because appellants state in their brief that the "claims stand or fall as a single group" (page 3). 37 CFR § 1.192(c)(7) (1995).

The reference relied on by the examiner is:

Seiki et al. (Seiki) (published Eur. Pat. Application)	0 461 262	Dec. 18, 1991

The examiner has rejected appealed claims 1 through 5 and 10 under 35 U.S.C. § 103 as being unpatentable over Seiki (answer, pages 2-3)[2] and has further rejected appealed claims 6 through 9 under 35 U.S.C. § 101 "because the 'use' of a composition is not a statutory class of invention" (answer, page 3).[3]

We affirm the ground of rejection under § 101 but reverse the ground of rejection under § 103.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellants' brief for a complete exposition thereof.

Opinion

[2] The statement of this ground of rejection appears in the final rejection of November 20, 1995 (Paper No. 11; pages 3-4).

[3] The examiner withdrew the rejection of claim 9 under 35 U.S.C. § 112, second paragraph (answer, page 2).

In order to consider the issues in this appeal involved with the application of Seiki to the claimed invention encompassed by appealed claim 1, we first must determine the invention encompassed by this claim as it stands before us, mindful that we must give the broadest reasonable interpretation to the terms thereof consistent with appellants' specification as it would be interpreted by one of ordinary skill in this art. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). We find that consistent with the "Summary of the Invention" and the example in the specification (pages 8 and 14-15), claim 1 is directed to "an oil prepared by esterification of a polyoxyethylene . . . [of] formula (I) . . . with *at least one* polycarboxylic acid compound . . . *and at least one* monocarboxylic acid compound . . . " (emphasis supplied), wherein the polycarboxylic and monocarboxylic acids are further defined in the claim with respect to carbon atoms content. We further find that one of ordinary skill in this art would have recognized from the disclosure in the specification (pages 8-10 and 14-15) that the product-by-process language thus employed in claim 1 specifies that the claimed "oil" is the esterified product from the reaction of a polyhydric polyoxyethylene alcohol of "formula (I)" with polycarboxylic *and* monocarboxylic acids, and thus is a *mixture* of esters. *See In re Thorpe*, 777 F.2d 695, 697-98, 227 USPQ 964, 966 (Fed. Cir. 1985). Indeed, such a mixture would comprise reaction products wherein at least one of the hydroxy functional moieties of the polyhydric polyoxyethylene alcohol compound is esterified by a polycarboxylic acid compound, thus resulting in, e.g., ester compounds containing at least one acid moiety having a carboxy functional group and ester compounds wherein a di-acid moiety links two polyoxyethylene alcohol moieties.

In arriving at our interpretation of claim 1, we recognize that the preamble of this claim recites "[a] compound suitable for use as a compressor lubricant." However, when considered in the context of the claimed invention as a whole, including consideration thereof in light of the specification, we find that this limitation is not necessary to characterize the specified "oil" reaction product in order to give meaning to claim 1 and properly define the invention. *See generally In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857 [225 USPQ 792] (1984), *Corning Glass Works v. Sumitomo Elect. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), *In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071,

1073 (Fed. Cir. 1987). Indeed, under the facts of this case, we find that the language of the preamble does not limit the scope of claim 1 to a "compound" as opposed to the "oil" reaction product mixture, or provide any further limitation on the "oil" mixture through the recitation that the same is "suitable for use as a compressor unit."

In applying Seiki to claim 1 as we have interpreted it above, we fail to find in the sole portion of this reference disclosing an ester of a polyoxylalkylene glycol, that is, formula (II) wherein one or more of R^5, R^7, or R^9 is "an acyl group having 1 to 20 carbon atoms" (page 3), any suggestion to one of ordinary skill in this art to form a mixture which would contain one or more of the esters so disclosed in the reference, which could be formed by the reaction of said glycol and suitable *mono*carboxylic acids, *and* esters formed by the reaction of said glycol and *poly*carboxylic acids with the reasonable expectation of arriving at the claimed "oil" mixture. Accordingly, in the absence of evidence or scientific reasoning advanced by the examiner establishing that Seiki would have provided such a suggestion and reasonable expectation of success in the absence of appellants' disclosure, we reverse this ground of rejection because the examiner has failed to establish a *prima facie* case of obviousness of the claimed invention encompassed by appealed claim 1 over the reference within the meaning of § 103.[4] *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531(Fed. Cir. 1988) ("Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.").

Turning now to the ground of rejection under § 101, we find that the language of appealed claim 6 when given its broadest possible interpretation in light of appellants' specification as it would be interpreted by one of ordinary skill in this art, *Morris*, *supra*, simply specifies a "use" and not a "process, machine, manufacture, or composition of matter, or any new or useful improvement thereof" for which a patent may be obtained as provided in this statutory provision. Indeed, the "[u]se of the

[4] We suggest that any further prosecution of the appealed claims before the examiner include consideration of the issue of whether these claims comply with the requirements of 35 U.S.C. § 112, second paragraph. We note in this respect that it appears that claim 5 and claims dependent thereon fail to find antecedent basis in any of claims 1 through 4 for "the hydrocarbon" specified in claim 5, and neither claim 5 nor the claims on which it depends recite "a compound (X)" as specified in claim 10 which is dependent on claim 5.

lubricant . . . in a closed refrigerator system which is of the compression type" neither claims a method of using the lubricant in such a system or a refrigerator system of the type specified which contains said lubricant. Furthermore, appellants have not presented in their brief any argument or authority with respect to whether claim 6 complies with § 101 (page 3-4). Accordingly, on this record, we affirm this ground of rejection.

In summary, we have reversed the ground of rejection of appealed claims 1 through 5 and 10 under 35 U.S.C. § 103 as being unpatentable over Seiki and have affirmed the ground of rejection of appealed claims 6 through 9 under 35 U.S.C. § 101.

The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

MARY F. DOWNEY Administrative Patent Judge	)	
BRADLEY R. GARRIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)	

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